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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/648,350	08/27/2003	David Ralph Emmert	263-4498	3424

7590 04/28/2006
GROSSMAN & FLIGHT, LLC
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EXAMINER

PASCUA, JES F

ART UNIT	PAPER NUMBER
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3727

DATE MAILED: 04/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/648,350

Applicant(s)

EMMERT, DAVID RALPH

Examiner

Jes F. Pascua

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 8-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 7 and 16-20 is/are rejected.
- 7) ☒ Claim(s) 5 and 15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/16/04.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-7 and 15-20 in the reply filed on 03/17/2006 is acknowledged. The traversal is on the ground(s) that the Examiner has not provided a viable alternative process or shown serious burden. This is not found persuasive because applicant has failed to show that the product as claimed cannot be made by the materially different process of providing the bottom liner with an adhesive top layer and then securing the first web of material on the adhesive top layer instead of "securing a bottom liner to the top printable sheet via the adhesive bottom layer" as claimed in process claims 9-14. Furthermore, the fact that the product and process claims are classified in separate statutory classes of invention is *prima facie* evidence of serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Claim 15 is objected to because of the following informalities: Claim 15 depends from non-elected claim 8. Appropriate correction in the form of amending claim 15 to read as an independent product-by-process claim is required. It is noted that paragraph 6 in the Office action mailed 02/17/2006 previously addressed claim 15. Applicant's 03/17/2006 reply regarding 15 is silent. Accordingly, claim 15 has not been further treated on the merits.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by UK Patent Application No. 2 268 466 to Hartill.

Hartill discloses envelope comprising a first web of material including a printable sheet 15 with an adhesive layer in the form of a dry peel adhesive and secured to the printable sheet 15 via the adhesive layer is a liner 14. A second web of transparent material 11 is fixed to the liner 14 via adhesive strips to define a transparent envelope. The transparent envelope is sealable by adhesive 17 located on liner 14 of the first web of material. Regarding claim 6, Hartill discloses the sheet 15 comprising address indicia.

The envelope of Hartill is considered to be “sized such that” it is “suitable for laser printing” to the same degree applicant sets forth the metes and bounds of the phrase “suitable for laser printing” in the claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 4, 6, 7, 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent No. 5,624,069 to Coats et al. and Hartill.

Coats et al. discloses the claimed device except it is unclear if the second web of material (i.e. the web of material of "first faces" 18, 25) is transparent. Hartill discloses that it is known in the art to use transparent material for the second web of an analogous assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use transparent material for the second web of material of Coats et al., since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As a note, the assembly of Coats et al. is considered to be "sized such that" it is "suitable for laser printing" to the same degree applicant sets forth the metes and bounds of the phrase "suitable for laser printing" in the claims.

7. Claims 2, 3 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coats et al. and Hartill as applied to claims 1 and 16 above, and further in view of U.S. Patent No. 4,928,874 to Henry et al.

Coats et al. and Hartill disclose the claimed device, as discussed above, except for the labels 37 being die cut from the sheet with the printing 42, 43. Henry et al. discloses that it is known in the art to provide die cuts 96, 98 between labels on an analogous printable sheet. See Figs. 4 and 5. It would have been obvious to one

having ordinary skill in the art at the time the invention was made to provide the labels 37 of Coats et al. with the die cuts of Henry et al., in order to permit separation of the labels from each other.

Allowable Subject Matter

8. Claim 5 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments

made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jes F. Pascua whose telephone number is 571-272-4546. The examiner can normally be reached on Mon.-Thurs..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Newhouse can be reached on 571-272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jes F. Pascua
Primary Examiner
Art Unit 3727

JFP